

REMARKS

By this amendment, Claims 27-35 have been added to provide more comprehensive protection for certain aspects of the invention. Accordingly, Claims 1-35 are pending.

Support for the newly presented claims can be found at least in Figs. 3A-3D and the description running from column 3, line 48 through column 5, line 8 of the Specification.

A March 5, 2003 Office Action in Parent Application No. 10/162,575 rejected Claims 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over JP 2-46511 to Narumi hereinafter "Narumi") in view of JP 5-342528 to Yabuta hereinafter "Yabuta"). The rejection is untenable as explained below.

Claim 25 recites, *inter alia*, a thin film magnetic recording head having a magnetic pole structure defining a pair of gaps. The gaps are arranged in succession along a predetermined direction. A single planar coil is capable of simultaneously magnetically energizing the gaps such that a portion of a recording medium moved across the gaps in a predetermined direction is preconditioned by one of the gaps prior to movement across the other of the gaps. Claim 26 is directed toward a method of manufacturing a comparable thin film magnetic recording head.

Narumi discloses a magnetic recording head with a single coil 4. As conceded in the Office Action, the single coil 4 of Narumi is not a planar coil. Moreover, Narumi is not concerned with a thin film structure. The Office Action pointed to Yabuta for the teaching of it being "well known in the art to provide thin film planar coils in lieu of the coil winding of Narumi in order to eliminate 'laborious coil winding.'"

Yabuta, however, is not directed toward adapting coil windings into thin film planar coils. Rather, Yabuta teaches that through the use of alignment marks 8, two core half bodies (1 and 2), each of which have thin film coils 4, can be aligned and joined to create a single coil. In this way, a signal from the coil can be obtained through signal line 5 since the signal line 5 is physically twisted through the winding section 7 and contacts the thin film coils 4.

The Office Action further stated that although Narumi as applied to Yabuta "does not expressly show a 'thin film' magnetic head, Official notice is taken that 'thin film' magnetic heads are, ubiquitous and notoriously old and well known in the art."

A *prima facie* case of obviousness has not and cannot be established based on the art of record. First, none of

the references of record suggests a thin film magnetic recording head or method of manufacture as claimed. Second, even assuming that Narumi and Yabuta are properly combinable (which they are not as will be evident below), the combination would not produce a thin film magnetic recording head as correctly recognized by the Office Action. Third, even if thin film magnetic recording heads are old and well known, is it well established law that the proposed modification of a reference cannot require a substantial reconstruction and redesign of the reference. And modifying Narumi into a thin film configuration would clearly require a complete redesign and reconstruction of Narumi's device. Absent the benefit of Applicant's teachings, one of ordinary skill in the art would have had no motivation whatsoever to engage in such wholesale modification of Narumi. The asserted motivation in the Office Action is thus clearly based on impermissible resort to hindsight in view of Applicant's own teachings, which are not part of the prior art.

Accordingly, the rejection of Claims 25 and 26 in the parent application is untenable and should not be repeated in the present application.

The patentability of newly presented Claims 27-35 will be apparent upon consideration of the claims in light of the foregoing remarks.

Examination on the merits and a prompt Notice of Allowance are respectfully requested.

The Commissioner is hereby authorized to charge to Deposit Account No. 50-1165 any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, and to credit any overpayment to that Account. If any extension of time is required in connection with the filing of this paper and has not been requested separately, then such extension is hereby requested.

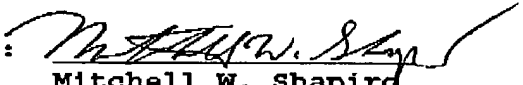
Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on June 21, 2004.


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